UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,514	10/20/2000	Paul Lapstun	NPS024US	7916

24011 7590 04/27/2007

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER
PHAM, THIERRY L

ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/693,514	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Thierry L. Pham	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-10,13-39 and 42-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-10,13-39 and 42-62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/4/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 4/15/07.
- Claims 1-4, 6-10, 13-39, 42-62 (pending); claims 5, 11-12, 40-41 (canceled); claim 62 (new).
- IDS filed on 4/4/07 has been considered and herein attached (PTO 1449) with Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 19, 37, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al (US 6330976), and in view of Moscato et al (US 6335978).

Regarding claim 1, Dymetman discloses a printer (col. 11, lines 55-60) including:

- a print mechanism (inherently, all printers include a print mechanism for printing data onto a physical medium, i.e., print media) for printing document information onto one or more of a plurality of print areas provided on a print area path (printed marking medium contains plurality of encoded data (i.e. page id and location id) with different zones/areas, figs. 3-10, col. 3, lines 56-60, col. 8, lines 45-67, and col. 9, lines 1-15), each of the print areas (each zones/areas contain different coded data, figs. 3-10, col. 3, lines 56-60, col. 8, lines 45-67, and col. 9, lines 1-15) including identity data indicative (i.e. information indicating zones/positions of the areas/zones within the document, figs. 3-10, col. 3, lines 56-60, col. 8, lines 45-67, and col. 9, lines 1-15) of identity information which differentiates the print area from others of the plurality.

Dymetman teaches a printer but does not explicitly include a feed mechanism for feeding print media through a media feed path. In addition, Dymetman also teaches a portable optical sensor 502 for sensing/detecting the coded data printed on the marking medium, but fails to teach and/or suggest such optical sensor 502 is positioned adjacent to the media feed path downstream of said print mechanism, said at least one sensor being configured such that all print media on

which said print mechanism has printed said document information are automatically sensed by said at least one sensor. .

Moscato, in the same field of endeavor for printing, teaches a printer (printer 15, fig. 3) including a feed mechanism (paper feed mechanism of printer 15, fig. 3) for feeding print media (media 17, fig. 3) through a media feed path and optical sensor (sensor 20, fig. 3) is positioned adjacent to the media feed path downstream (downstream, fig. 3, col. 5, lines 12-14) of said print mechanism and at least one sensor (sensors 20, fig. 3, col. 5, lines 10-67) being configured such that all print media (all printed media, fig. 3) on which said print mechanism has printed said document information are automatically sensed (automatically sensed, fig. 3, col. 5, lines 10-67) by said at least one sensor.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Dymetman as per teachings of Moscato by incorporating the optical sensor within the printer because of a following reason: (•) an optical sensor can be either portable and/or incorporated within the printer itself; (•) to verify if the coded data has been printed correctly (as per teachings of Moscato, abstract and col. 3, lines 1-22).

Therefore, it would have been obvious to combine Dymetman with Moscato to obtain the invention as specified in claim 1.

Regarding claims 19 & 37 recite limitations that are similar and in the same scope of invention as to those in claim 1above; therefore, claims 19 & 37 are rejected for the same rejection rationale/basis as described in claim 1.

Regarding claim 62, Moscato further teaches the printer of claim 1 comprising a pair of said sensors (sensors 20, fig. 3).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman and Moscato as described in claims 1, and further in view of Ur (US 6072871).

The combinations of Dymetman and Moscato discloses a marking medium contains both coded data and human readable information (col. 14, lines 39-45, col. 35-39, and col. 19, lines

33-42) but fails to teach and/or suggest the printer includes a print mechanism for printing on at least two of print areas substantially simultaneously.

Ur, in the same field of endeavor for printing, teaches an ink jet printer (printer 17, fig. 1) prints the coded data at the same time as printing the document on the surface defining structure (prints coded data 27 and document texts as shown in fig. 2 at the same time, col. 4, lines 41-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Dymetman and Moscato as per teaching of Ur because of a following reason: (•) reduce hardware costs and time by printing both coded data and document data simultaneously.

Therefore, it would have been obvious to combine Moscato, Dymetman, and Ur to obtain the invention as specified in claim 14.

Claims 9, 25, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman and Moscato as described in claims 1, 19, and/or 37 above, and further in view of Mizutani (U.S. 6078400).

Regarding claims 9, 25, and 44, Mori does not explicitly disclose a means to detect failure to correctly print document information onto a print area and for generating a void signal on detection of said failure, the transmitter transmitting said void signal to the computer system.

Mizutani, in the same field of endeavor for printing, teaches a means (error detection device, fig. 3a) to detect failure to correctly print document information onto a print area and for generating a void signal (error signal, cols. 3-4) on detection of said failure, the transmitter (network, fig. 1) transmitting said void signal to the computer system.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Moscato and Dymetman as per teachings of Mizutani because of a following reason: (1) to correctly sense/detect the errors occurred while printing and/or within the printers and to quickly resolve such errors as per teachings of Mizutani; therefore, provides high output quality prints.

Therefore, it would have been obvious to combine Moscato and Dymetman with Mizutani to obtain the invention as specified in claims 9, 25, and 44.

Claims 2-4, 6-10, 13, 15-18, 20-36, 38-39, 42-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman and Moscato as described in claims 1, 19, and 37, and further in view of Mori (US 6137590).

Regarding claim 2, the combinations of Dymetman and Moscato fail to teach and/or suggest the identity data is represented on the print data in a coded form and the printer includes a decoder which receives coded data from the at least one sensor and outputs decoded data representing at least the identity data or at least the identity information.

Mori, in the same field of endeavor for printing coded data, teaches a well-known example of the identity data is represented on the print data in a coded form (coded data 10a, fig. 2) and the printer includes a decoder (col. 5, lines 10-25) which receives coded data from the at least one sensor and outputs decoded data representing at least the identity data or at least the identity information.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Dymetman and Moscato as per teachings of Mori by printing identity data in form of coded because of a following reason: (•) coded marking medium provides a faster and better (col. 11, lines 35-60 of Mori) method for retrieving document data (i.e. in digital copy) using optical sensor device rather than manually by users via keyboard and etc; (•) resolution of original image can easily maintained via using coded data (col. 14, lines 39-45 of Mori).

Therefore, it would have been obvious to combine Dymetman and Moscato with Mori to obtain the invention as specified in claim 2.

Regarding claim 3, Dymetman further discloses the printer of claim 1 wherein each identity information is represented on the print area by at least two discrete items (i.e. page id and location id, col. 9, lines 5-15) of data and the decoder outputs decoded data representing at least the identity information after receiving said at least two separate items of data.

Regarding claim 4 & 6, Mori further discloses the printer of claim 1 wherein said at least one sensor is positioned to sense said identity data before/during/after printing of the document information on the respective print area (col. 6, lines 1-15).

Regarding claims 7-8, 10, Mori further discloses the printer of claim 1 further including a transmitter (network, figs. 17-19) for transmitting information to a computer system.

Regarding claim 13, Mori further discloses the printer of claim 1 operable to over-print a print area having existing document (text over graphic is well known in the art) information to render the existing document information unreadable.

Regarding claim 15, Mori further discloses the printer of claim 1 wherein the at least one sensor is selected from an image sensor (col. 5, lines 10-45) and a magnetic sensor and a chemical sensor.

Regarding claims 16-17, Mori further discloses the printer of claim 1 wherein the printer generates at least some of the information printed (medium 10 with printed information, fig. 7).

Regarding claim 18, Mori further discloses the printer of claim 1 further including a user interface (control panel as shown in fig. 2) to enable user to input identity information into the printer.

Regarding claims 20-24, 26-36 recite limitations that are similar and in the same scope of invention as to those in claims 2-4, 6-8, 10,13-18 above; therefore, claims 20-24, 26-36 are rejected for the same rejection rationale/basis as described in claims 2-4, 6-8, 10,13-18.

Regarding claims 38-39, 42-43, 45-58, which are the method claims corresponding to the apparatus claims 1-4, 6-8 and 10, 13, 15-18 and are in the same scope of invention. The method claims are included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-4, 6-8 and 10, 13, 15-18 above.

Regarding claim 59-61, Dymetman further discloses each print area including identity data indicative of an identity of the respective print area (zones/areas, cols. 11-12).

Response to Arguments

Applicant's arguments, see pages 10-11, filed 3/20/07, with respect to the rejection(s) of claim(s) 1, 19, and 37 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham

Gabriel Garcia

GABRIEL I. GARCIA
PRIMARY EXAMINER